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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of:	Confirmation No.: 7398
Gerald Isaac Kestenbaum	Date: December 23, 2008
Serial No.: 09/587,525	Group Art Unit: 3629
Filed: June 5, 2000	Examiner: Naresh Vig
For: APPARATUS AND METHOD FOR PROVIDING BUILDING MANAGEMENT INFORMATION	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY TO EXAMINER'S ANSWER MAILED OCTOBER 23, 2008

Sir:

This Reply is in support of the Appeal Brief filed on July 25, 2008 and concerns the propriety of the Examiner's final rejection mailed January 25, 2008 in connection with the above-identified patent application and Examiner's Answer mailed October 23, 2008.

A. Response to Section 10 of the Answer

The Examiner correctly indicates at Section 9 that claims 98-100, 102-111, 113-118, 121-134, 139-143 and 159-160 stand rejected under 35 U.S.C. §103(a). The statement of the status of claims in Appellant's brief incorrectly indicates that claims 121, 112 and 136 stand rejected under 35 U.S.C. §112.

The Examiner states in his Answer at Section 10, however, that "Claim 121 had not been deemed patentable [sic] under 35 USC 112, first paragraph," and "Claims 112 and 136 had not been deemed patentable under 35 USC 112, second paragraph[.]" Appellant presumes the Examiner intended to state that those claims had not been "rejected," as opposed to "patentable."

B. Response to Sections 9 and 10 of the Answer

At page 19 of the Examiner's Answer, the Examiner cites to a passage submitted in Appellant's appeal brief. In that passage, Appellant noted that by inserting the phrase, "an individual associated with management" in Appellant's independent claim 98, the Examiner considered all of the limitations of claim 98 to be met, which is clearly wrong. The Examiner responds in his Answer by citing to the "Super" in Aihara, who can be considered a tenant and, therefore, information can be exchanged between other tenants and the Super "(person relating to the management of the building)." Applicant maintains that limitations of claim 98 are not met.

Moreover, at page 5 of the Answer (Section 9), the Examiner continues this line of reasoning by addressing some claim 98 limitations:

"i) to receive a communication relating to management of said building from a device associated with at least one of said tenants, said communication including data indicating an instruction being associated with a task performed by said individual, said individual being associated with a front desk of said building, a front gate of said building, or a combination thereof[.]"

In the Answer's Grounds of Rejection, and in consideration of these limitations, at page 5, the Examiner concludes that the "appellant is claiming type of users for exchange and type of message generated by the tenant." Respectfully, this is overly simplistic and does not address the claim limitations of a "communication ... including data indicating an instruction." Also at page 5, the Examiner addresses Appellant's claim 98 limitations "ii) to associate said instruction with said at least one of said tenants using an identifier" and "iii) to store said instruction and said identifier on said computer system." The Examiner erroneously cites to e-mail for teaching Appellant's "instruction" and "[associating]" and "[storing]."

Appellant maintains that Aihara's e-mail system is not tantamount to Appellant's claim 98 collaborative real estate management system because Aihara's system does not teach, disclose or suggest "data" in a communication that include an "instruction" and that is "associated" with a task, that is further "associated" with one or more tenants, and that is "stored" in a computer system. While Aihara's e-mail communication, *per se*, may be stored, and associated with a sender and targeted recipient(s), the "data" of the e-mail, including any instructions that may be submitted by a sender, are not "[associated]" with a task, are not "[associated]" with tenant(s), and are not "[stored]." Aihara's system simply deals with e-mail communication, and

Appellant's claim 98 is patentably distinct by dealing with "data" indicating an instruction that are included with the "communication."

At page 21 of the Answer and in connection with the Examiner's response to Appellant's arguments for patentability of claim 114, the Examiner states "there is no update to the information[.]" Respectfully, this is unresponsive to Appellant's arguments that claim 114, which requires "storing information regarding pick-up" and "associating said stored information with said instruction" is patentable. Respectfully, updating information is not the point, but rather that Aihara's e-mail system, which stores communications, is incapable of Appellant's feature of storing "information regarding pick-up," and is further incapable of "associating" the information with the "instruction" that is "[indicated]" in "data" in the "communication." Furthermore and in connection with Appellant's argument that "information regarding pick-up" was never included in an original instruction, the Examiner responds by alluding to groups of e-mail that can be associated by "subject [lines]." E-mail subject lines, however, are included in original e-mail communications and, in any event, are not associated with an "instruction" in "data" and "stored" on a computer system. Again, the patentable distinction of Appellant's claimed invention over Aihara is simply not addressed by the Examiner.

At page 22 of the Answer, the Examiner supports a conclusion of obviousness by alluding to businesses preferring to purchase "off the shelf packages to save on development and maintenance costs." The Examiner appears to be concluding, therefore, that any programmed computer system is obvious in view of programming development environments, including programming languages such as C, C++, Java, Visual Basic, that are available for "development."

Moreover, at page 23 of the Answer, the Examiner discounts Appellant's submitted declaration evidencing secondary considerations of non-obviousness, including commercial success, solving a long felt need and licensing, by attributing such features to "successful advertising." Appellant respectfully submits this is simplistic, disingenuous and, again, non-responsive.

Appellant maintains that, in view of the above-cited responses to Appellant's arguments and to all of the Examiner's responses and arguments set forth in the Answer do not support a conclusion that Appellant's claims are unpatentable. The Examiner has not cited to one or more references that teach, disclose or suggest the combination of features set forth in Appellant's

claims, and instead makes sweeping generalizations, such as at page 22, that Appellant's claimed invention is obvious.

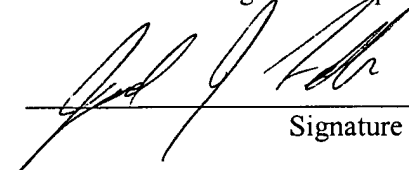
CONCLUSION:

For the reasons set forth above, it is respectfully submitted that all rejections to the claims in this application have been addressed to clearly define over the prior art. Therefore, the Examiner is respectfully requested to reconsider the application and allow the case to issue.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 15-0700.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 23, 2008:

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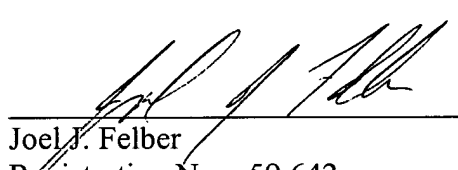


Signature

December 23, 2008
Date of Signature

RCF:JFF:ck

Respectfully submitted,



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